



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/183,791	10/30/1998	PETER G. JACOVES	FMSI-24.440	3525

7590

12/02/2003

Thomas R. Felger, Esq.
Baker Botts LLP
2001 Ross Avenue
Dallas, TX 75201

EXAMINER

KAZIMI, HANI M

ART UNIT PAPER NUMBER

3624

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/183,791

Applicant(s)

JACOVES ET AL.

Examiner

Hani Kazimi

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 63-88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 63-88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 38
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 3624

DETAILED ACTION

1. This communication is in response to Applicant's amendment filed on June 4, 2003.

Claims 63-88 are pending. The rejections are as stated below.

Response to Applicants' Amendment

Claim Objections

2. Claim 87 is objected to because of the following informalities:

Claim 87 depends on "claim 12". However, claim 12 has been canceled. A claim cannot depend on a canceled claim, for purpose of examination only, examiner assumes that claim 87 is dependent on claim 86. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 75 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, claim 75 contains two periods. It is not clear to where the claim is ending.

Art Unit: 3624

For further examination purposes, examiner will assume that the claim intends to end at the end of the second period. Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 63-65, 74, 75, 77, and 78 are rejected under 35 U.S.C. § 101 because, the claimed invention is directed to a non-statutory subject matter. Specifically the method claims as presented do not claim a technological basis in the pre-amble and the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the body of the claim at least one structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential].

In order to over come the 101 rejection above, the following preamble is suggested:

“A computer implemented method for ---”, or something similar. Also, in the body of the claim include at least one structural / functional interrelationship which can only be computer implemented.

Art Unit: 3624

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent May not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

9. Claims 63-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greer et al. European Pat. No. 0 511 463 A2 in view of McCall US Pat. No. 6,112,981.

Claims 63-88, Greer teaches a method and a corresponding system for discounting of a consumable good by determining a first discount on of a consumable good in response to a first purchase by the customer of a first preselected product, determining a second discount of a consumable good in response to a second purchase by the customer of a second preselected

Art Unit: 3624

product, and determining a total discount of the consumable good by adding the first and second discount. Greer teaches the steps of issuing a coupon to the customer, storing the first discount in a database in association with the customer identification and transaction identifier, and reducing the consumable good by the first discount (col. 2, line 54 thru col. 3, line 55, and column 5, line 30 thru column 9, line 51).

Greer fails to teach that the discount is based on a Price Per Unit (PPU), and the steps of storing in a database a maximum and a minimum number of gallons to which the discount applies.

McCall teaches that the discount is based on a Price Per Unit (PPU), and the steps of storing in a database a maximum and a minimum number of gallons to which the discount applies. (Figs. 5-6, and column 6, lines 20-65).

It would have been obvious to one of ordinary skilled in the art at the time the Applicant's invention was made to modify the teachings of Greer to include the steps of granting the customer a discount based on a Price Per Unit (PPU), and storing in a database a maximum and a minimum number of gallons to which the discount applies. because, Greer provides a database that contains information concerning the discount deals that are in effect for the purchased product, "specifically the amount of discount", (Greer column 5, lines 35-43).

Response to Arguments

10. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection. However, with respect to Applicant's request of declaring an Interference between the present application and US Pat. No. 6,332,128 B1, and US Pat.

Art Unit: 3624

Application 20020040321 both to "Nicholson", the Examiner will declare the Interference when the application is in condition for allowance. The cited section of the MPEP 2307.02 by Applicant for the Examiner to initiate the interference is a recommendation not a requirement. Even though the Examiner has suggested that the Interference will be declared when the count claim is in condition for allowance, the Examiner will declare the Interference when the application is condition for allowance in light of the newly cited reference. Furthermore, the pending claims might have an effect on the Interference with respect to the obviousness rejections.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687 or 7658.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 1114.

Serial Number: 09/183,791

7

Art Unit: 3624

Art Unit 3624

August 11, 2003



VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600



JOHN J. LOVE
DIRECTOR
TECHNOLOGY CENTER 3600